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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,465	07/11/2001	Kirk Steven Tecu	10016935-1	9335

7590 05/23/2006

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
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EXAMINER

SAFAIPOUR, HOUSHANG

ART UNIT	PAPER NUMBER
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2625

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/903,465	Applicant(s) TECU ET AL.	
	Examiner Houshang Safaipoor	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 13-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-19 is/are allowed.
- 6) ☒ Claim(s) 1-7 and 20-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/7/03 & 10/21/05</u> . | 6) <input type="checkbox"/> Other: _____ |

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PTOL-326

DETAILED ACTION

Response to Amendment

Applicant's amendment filed on February 27, 2006 has been entered and made of record.

Applicant's arguments with regards to claims 1-7 have been considered, but are not persuasive. Applicant's arguments with regards to claims 13-19 have been considered but are moot in view of allowance of claims 13-19. Newly added claims 20-24 are analogous to claims 1, 3, 4, 6 and 7 respectively and are therefore rejected.

Claims 8-12 are cancelled.

Response to Arguments

Applicant argues that the prior art by "Kurosawa appears to be limited to transmissive scanning". Examiner agrees with applicant's conclusion. However, independent claim 1 recites that "the optical pattern indicating at least one of reflective scan routine and a transparent scan routine". Therefore, Kurosawa that discloses transmissive (transparent) scanning satisfies one of the two scan routines indicated by claim 1. For this reason, examiner maintains his rejection regarding claims 1-7.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 2, 3, 5-7, 20, 21, 23 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Kurosawa et al. (U. S. Patent No. 6,714,324).

Regarding claims 1 and 20, Kurosawa et al. discloses a template for a scanner system, the template comprising:

a template body (fig. 4, 201a and 201b) adapted to receive a media object to be scanned, and

an element for generating an optical pattern when scanned in the scanner system, the optical pattern indicating a particular scan routine for scanning the media object (fig. 4, element 206a or 206b).

Regarding claim 2, Kurosawa et al. discloses the template according to claim 1, wherein the template further comprises an insert area for receiving a transparent media therein (fig. 4, insert areas 203a or 203b).

Regarding claims 3 and 21, Kurosawa et al. discloses the template, wherein the element is a pattern printed on the template body (fig. 4, bar codes 206a or 206b).

Regarding claim 5, Kurosawa et al. discloses the template according to claim 1, wherein the element is an aperture on the template body (fig. 1, 204a or 204b)

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Regarding claims 6 and 23, Kurosawa et al. discloses the template, wherein the optical pattern is comparable to one or more reference patterns stored in a computer (col. 5, lines 10-33).

Regarding claims 7 and 24, Kurosawa et al. discloses the template, wherein the computer directs the scanner system to execute a scan routine upon determining a match between the optical pattern and one of the reference patterns (controller 140, col. 6, lines 19-65).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurosawa et al. (U. S. Patent No. 6,714,324).

Regarding claims 4 and 22 Kurosawa does not disclose expressly a tab connected to an edge of the template body.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to connect the tab to the edge of the template. Applicant has not disclosed that the tab provides an advantage, is used for a particular purpose or solves a stated problem. Therefore, it would have been obvious to one of ordinary skill in this art to modify Huang's apparatus to obtain the invention as specified in claims 4 and 22.

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Allowable Subject Matter

Claims 13-19 are allowed for the reason that the prior art does not teach in claimed combination a reflective scanner, a transparent media adapter and a template to receive a media for scanning with an element for generating an optical pattern when scanned in the scanner system.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Contact Information

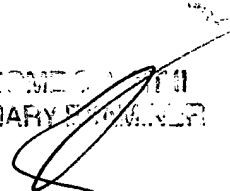
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Houshang Safaipoor whose telephone number is (571)272-7412. The examiner can normally be reached on Mon.-Thurs. from 6:30am to 5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 Houshang Safaipoor
Patent Examiner
Art Unit 2625
May 12, 2006


JEROME SMITH
PRIMARY EXAMINER